

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

CAUMONT-BERTRAND ET AL. Atty. Ref.: 3665-186; Confirmation No. 2862

Appl. No. 10/585,329 TC/A.U. 1626

Filed: July 6, 2006 Examiner: Shaio

For: 1,3-DIPHENYLPROP-2-EN-1-ONE DERIVATIVE COMPOUNDS, PREPARATION
METHOD THEREOF AND USES OF SAME

* * * * *

July 10, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE

Responsive to the Official Action dated June 11, 2008, the applicants elect, with traverse, the subject matter of the Examiner's Group II, i.e., claims 19-32 and 34-36 in part, drawn to compounds of formula (I) "not embraced in Group I". See page 2 of the Office Action dated June 11, 2008.

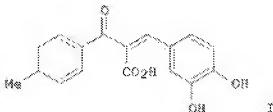
Withdrawal of the election requirement and examination of all of the claimed subject matter are requested as the Examiner has failed to establish that the claims do not relate to a single invention or to a group of inventions so linked as to form a single general inventive concept.

The Examiner will appreciate that the present application is a U.S. national phase of a PCT such that the principles of unity of invention apply. The Examiner has failed to

establish, such as citation to prior art teaching an aspect of the claimed invention, that unity of invention does not exist.

The applicants note in this regard that the Examiner has cited to Wang et al CAS: 148: 379286 to allegedly support the assertion that unity of invention fails to exist. The applicants note however that the cited Abstract, which is listed on the Examiner's PTO 892 without a year of publication, was published in 2007 and reports a "SOURCE" as "Molecules (2007), 12(4), 885-895 " (Title: Synthesis and activity of a new series of (Z)-3-phenyl-2-benzoylpropenoic acid derivatives as aldose reductase inhibitors; Authors: Wang et al). The present application however was filed a PCT International Application on January 7, 2005 and claims benefit from applications filed in France on January 8, 2004 and September 1, 2004. The cited Wang et al is not prior art to the presently claimed invention and can not be the basis for establishing that the presently claimed invention allegedly fails to define a contribution over the art.

Furthermore, compound CAS 148:379286 cited by the examiner:



is not a compound of formula (I) as defined in the present application. In particular, the compound disclosed in Wang et al. comprises a carboxyl group (-COOH) in position 2 of the propene chain located between the two phenyl moieties. However, this position is not substituted in the compounds of the present invention. Accordingly, compound CAS

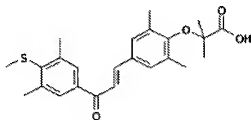
148:379286 of Wang et al. is not prejudicial to the unity of the present invention even if it were citable prior art.

Withdrawal of the lack of unity of invention determination and examination of all of the claimed subject matter are requested.

In the event the election requirement is maintained, the applicants further request clarification as to the Examiner's rationale for defining the subject matter of Group I as

"compounds of formula (I), wherein when the variable Ri or R'i represents heterocycle group selected from [1,2]dithiolane or morpholine thereof."

As a single species for search purpose, the applicants elect the following compound number 13:



Withdrawal of the election of species requirement is requested along with examination of all of the claimed subject matter.

An early and favorable Action on the merits is requested.

Applicants reserve their right to file further continuing, continuation or divisional applications at a later stage with respect to any subject matter not examined or retained in the present claims.

CAUMONT-BERTRAND ET AL.
Appl. No. 10/585,329
Atty. Ref.: 3665-186
Response
July 10, 2008

Respectfully submitted,

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